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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/583,216
Filing Date: May 30, 2000
Appellant(s): LEONARDO ET AL.

Russell D. Slifer
For Appellant (Reg. No.39,838)

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 14th, 2005 appealing from the Office action mailed March 11, 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of Invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192 (c) (7) and (c) (8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

(2001/0041993)	Campbell	11-15-2001
(2004/0059596)	Vaidyanathan et al.	03-25-2004

(10) Grounds of Rejection

The following ground (s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action. The rejection is set forth below as it is presented in this Office Action.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaidyanathan et al (2004/0059596) in view of Campbell (US 2001/0041993).

(A) As per claim 1, Vaidyanathan discloses a computer-implemented method for a network-based facility (See Vaidyanathan Page 3, Paragraph 0039), the method comprising:

facilitating a submission of a complaint to the network-based facility, the complaint relating to a network-based transaction (See Vaidyanathan Page 3, Paragraph 0044);

associating an identifier to the complaint (See Vaidyanathan, Page 5, Paragraphs 0051-0058);

facilitating a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

a first party and a second party, the first party and the second party generating the network-based transaction and facilitating a dialog between the first party and the second party to provide a resolution of the complaint associated with the identifier (See Vaidyanathan, Page 3, Paragraphs 0039-0044).

Vaidyanathan does not explicitly disclose facilitating a claim for insurance if the complaint is not resolved.

However, this feature is known in the art, as evidenced by Campbell. In particular, Campbell suggests facilitating a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the feature of Campbell within the system of Vaidyanathan with the motivation of resolving an electronic commerce dispute involving

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one or more parties by selecting one of two modes of resolving the dispute, the first mode being completely driven by an electronic agent and the second mode involving a dispute resolution specialist; and presenting the resolution of the dispute to the one or more parties (See Vaidyanathan, Page 2, Paragraph 0010).

(B) As per claim 2, Vaidyanathan discloses the method wherein the network-based facility is a network-based online auction facility and the network-based transaction is a network-based online auction transaction (See Vaidyanathan Page 3, Paragraph 0044).

(C) As per claim 3, Vaidyanathan discloses the method wherein the facilitating of the submission of the complaint includes: providing an interface for at least one of the parties to input information for the complaint (See Vaidyanathan, Page 4, Paragraph 0046).

(D) As per claim 4, Vaidyanathan discloses the method wherein the providing of the interface includes: providing an interface for the first party and an interface for the second party (See Vaidyanathan, Page 5, Paragraphs 0051-0055).

(E) As per claim 5, Vaidyanathan discloses the method wherein the facilitating of the resolution includes: providing a status interface for one of the parties to view a current status or provide comments related to the complaint associated with the

identifier and an interface to report a status of the complaint associated with the identifier (See Vaidyanathan, Page 5, Paragraphs 0051-0058).

(F) As per claim 6, Vaidyanathan discloses the method wherein the providing of the status interface includes: providing an interface for one of the parties who is complained against to input comments related to the complaint associated with the identifier (See Vaidyanathan, Page 5, Paragraphs 0051-0058).

(G) As per claim 7, Campbell discloses the method wherein the facilitating of the claim for insurance includes: providing an interface for one of the parties to file an insurance claim if the complaint has not be resolved after a certain period of time (Page1, Paragraph 0006).

The motivation for combining the respective teachings of Vaidyanathan and Campbell are as discussed above in the rejection of claim 1, and incorporated incorporated herein.

(H) As per claim 8, Vaidyanathan discloses the method wherein the facilitating of the resolution includes: providing an interface allowing one of the parties who is complained against to respond to the complaint (See Vaidyanathan, Page 5, Paragraphs 0051-0058).

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(I) As per claim 9, Vaidyanathan discloses the method wherein the facilitating of the resolution includes: exchanging comments between the first party and the second party regarding the complaint associated with the identifier, wherein the first party is a complaining party and the second party is a complained against party (Page 7, Paragraphs 0074-0078).

(J) As per claim 10, Vaidyanathan discloses a network-based facility system, comprising: a database configured to maintain records of network-based transactions (See Vaidyanathan Page 3, Paragraph 0039) and;

facilitate a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

a processing unit configured to facilitate a submission of a complaint from a first party against a second party, the complaint relating to a network-based transaction record maintained by the database, the network-based transaction being between the first party and the second party, to associate an identifier to the complaint (See Vaidyanathan, Page 3, Paragraphs 0039-0044), to facilitate a dialog between the first party and a second party to provide a resolution of the complaint associated with the identifier (See Vaidyanathan, Page 3, Paragraphs 0039-0044).

Vaidyanathan does not explicitly disclose facilitate a claim for insurance if the complaint is not resolved.

However, this feature is known in the art, as evidenced by Campbell. In particular, Campbell suggests facilitate a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the feature of Campbell within the system of Vaidyanathan with the motivation of resolving an electronic commerce dispute involving one or more parties by selecting one of two modes of resolving the dispute, the first mode being completely driven by an electronic agent and the second mode involving a dispute resolution specialist; and presenting the resolution of the dispute to the one or more parties (See Vaidyanathan, Page 2, Paragraph 0010).

(K) As per claim 11, Vaidyanathan discloses the network-based facility system wherein the network-based transaction record is a network-based online transaction record (Page 4, Paragraph 0044).

(L) As per claim 12, Vaidyanathan discloses the network-based facility system wherein the processing unit is further configured to provide an interface for the first party to input information for the complaint (See Vaidyanathan, Page 4, Paragraph 0046).

(M) As per claim 13, Vaidyanathan discloses the network-based facility system wherein the processing unit is further configured to provide an interface for the first party and an interface for the second party, wherein the first party is a buyer involved in the

network-based transaction and the second party is a seller involved in the network-based transaction (See Vaidyanathan, Page 3, Paragraphs 0039-0044).

(N) As per claim 14, Vaidyanathan discloses the network-based facility system wherein the processing unit is further configured to provide a status interface for each of the parties to view a current status and provide comments related to the complaint associated with the identifier and an interface to report a status of the complaint associated with the identifier (See Vaidyanathan, Page 5, Paragraphs 0051-0058).

(O) As per claim 15, Vaidyanathan discloses the network-based facility system wherein the processing unit is further configured to provide an interface for the second party who is complained against to input comments related to the complaint associated with the identifier (See Vaidyanathan, Page 5, Paragraphs 0051-0058);

(P) As per claim 16, Campbell discloses the network-based facility system wherein the processing unit is further configured to provide an interface for the first party to file an insurance claim if the complaint has not be resolved after a certain period of time (Page 1, Paragraph 0006; Page 5, Paragraph 0048).

The motivation for combining the respective teachings of Vaidyanathan and Campbell are as discussed above in the rejection of claims 1 and 10, and incorporated incorporated herein.

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(Q) As per claim 17, Campbell discloses the network-based facility system wherein the processing unit is further configured to provide an interface allowing the second party who is complained against to respond to the complaint (Page 4, Paragraph 0037-0038).

The motivation for combining the respective teachings of Vaidyanathan and Campbell are as discussed above in the rejection of claims 1 and 10, and incorporated herein.

(R) As per claim 18, Vaidyanathan discloses the network-based facility system wherein the processing unit is further configured to facilitate exchange of comments between the first party and the second party regarding the complaint associated with the identifier (See Vaidyanathan, Page 3, Paragraphs 0039-0044).

(S) Claim 19 differs from claims 1 and 10 by reciting a machine-readable medium that provides instructions, which when executed by a machine.

As per this limitation, it is noted that Vaidyanathan discloses said machine to perform operations comprising: facilitating a submission of a complaint to the network-based facility, the complaint relating to a network-based transaction (Page 3, Paragraph 0039); between a first party and a second party, the first party and the second party generating the network-based transaction; facilitating a dialog between the first party and the second party to provide a resolution of the complaint associated with the

identifier (See Vaidyanathan, Page 3, Paragraphs 0039-0044) and Campbell discloses associating an identifier to the complaint (Page 5, Paragraphs 0051-0058).

Thus, it is readily apparent these prior art systems utilize a machine-readable medium that provides instructions to perform the their specified function.

The remainder of claim 19 is rejected for the same reason given above for claims 1 and 10, and incorporated herein.

(T) As per claim 20, Vaidyanathan discloses the machine-readable medium wherein the network-based facility is a network-based online auction facility and the network-based transaction is a network-based online transaction (See Vaidyanathan Page 3, Paragraph 0039).

(11) Response to Arguments

In the Appeal Brief filed 07/14/05, Appellant makes the following argument:

Neither the Vaidyanathan nor Campbell reference, whether taken separately or in combination, describe all the limitations of claims. In making this argument, Appellant makes the following points:

- (i) The cited references do not teach or suggest all claim limitations, when considered singularly or in combination.
- (ii) Neither reference discloses or suggests a computer-implemented method for a network-based facility comprising associating an identifier to a complaint in claim 1.

Regarding claim 10, neither reference discloses or suggests a processing unit configured to associate an identifier to a complaint.

Regarding claim 19, neither reference discloses or suggests a machine-readable medium that provides instructions, which when executed by a machine, cause said machine to associate an identifier to a complaint.

(iii) Vaidyanathan reference does not explicitly disclose facilitating a claim for insurance if the complaint is not resolved.

(iv) There is no suggestion in either the Vaidyanathan or Campbell reference to combine the general idea of a computer-based insurance claim management system of Campbell with the dispute resolution of Vaidyanathan. Appellant maintains that combining the references is impermissible hindsight reconstruction.

Examiner will address Appellant's argument and related points in sequence as they appear in the Brief.

(i) With respect to Appellant first point of argument, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d.1038, 1039,228 USPQ 685, 686 (Fed. Cir.1992); *In re Piasecki*, 745F. 2d 1468, 1472, 223 USPQ 785, 788 (Fed.Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly

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articulated the combinations and the motivations for combinations that fairly suggest.

Appellant's claimed invention. Note, for example, in rejection of claim 1, Examiner had stated the following:

As per claim 1, Vaidyanathan discloses a computer-implemented method for a network-based facility (See Vaidyanathan Page 3, Paragraph 0039), the method comprising:

facilitating a submission of a complaint to the network-based facility, the complaint relating to a network-based transaction (See Vaidyanathan Page 3, Paragraph 0044);

associating an identifier to the complaint (See Vaidyanathan, Page 5, Paragraphs 0051-0058);

facilitating a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

a first party and a second party, the first party and the second party generating the network-based transaction and facilitating a dialog between the first party and the second party to provide a resolution of the complaint associated with the identifier (See Vaidyanathan, Page 3, Paragraphs 0039-0044).

Vaidyanathan does not explicitly disclose facilitating a claim for insurance if the complaint is not resolved.

However, this feature is known in the art, as evidenced by Campbell. In particular, Campbell suggests facilitating a claim for insurance if the complaint is not resolved (See Campbell, Page 5, Paragraph 0048).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the feature of Campbell within the system of Vaidyanathan with the motivation of resolving an electronic commerce dispute involving one or more parties by selecting one of two modes of resolving the dispute, the first mode being completely driven by an electronic agent and the second mode involving a dispute resolution specialist; and presenting the resolution of the dispute to the one or more parties (See Vaidyanathan, Page 2, Paragraph 0010).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinary skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the previous Office Action, incorporated herein, *Ex parte Levengood*, 28 USPQ2D 1300 (Bd. Pat. App. & Inter., 4/22/93).

(ii) With respect to Appellant second point of argument, the Examiner respectfully submitted Appellant further fails to properly consider the clear and unsmistakable teachings of the applied references, and further fails to properly consider the breadth of the claim limitations presently argued. Furthermore, the Examiner respectfully submitted that He has relied upon the reference of Vaidyanathan for such a feature. Note that Vaidyanathan suggests "It also assists the dispute resolution specialist in identifying similar past cases and indicating likely outcomes and their associated certainty. The system matches new disputes to "cases" from a historical database and then adapting successful outcomes from the past to the current situation. This technique increases the

efficiency of the dispute resolution process and provides a high degree of decision uniformity. This effectively creates a semi-automated precedent-based resolution system" which correspond to Appellant's claimed feature (See Vaidyanathan, Page 3, Paragraphs 0021-0023). It appears that Appellant seeks to assign a specific meaning to the term "identifier to a complaint" which is not explicitly defined via a positive and concrete definition within the present specification, nor further defined in the bodies of the pending claims. As such, the Examiner respectfully submitted that such terms were given their broadest reasonable interpretations during examination, and since the applied reference clearly discloses the claimed limitations, when given their broadest reasonable interpretations, it is respectfully submitted that the Examiner's reliance on Vaidyanathan is indeed proper.

(iii) With respect to Appellant third point of argument, the Examiner respectfully submitted that He had already addressed this limitation in the previously Office Action, and incorporated herein as of 05/06/04. Therefore, Appellant's argument is not persuasive.

(iv) With respect to Appellant's fourth point of argument, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,

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788 (Fed. Cir.1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art by expressly pointing to specific portions of each applied reference and has expressly articulated the combinations and the motivations for combinations as well as the scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention.

Each applied reference does not expressly suggest combination with the other respective references; however, the Examiner has shown that motivation for combining the references existed in the prior art. Within the present combinations, all of the modifications proposed by the Examiner are taught by the references and that knowledge generally available to one of ordinary skill in the art. Therefore, the combination of references is proper and the rejection maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Appellant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

Nonetheless, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the previous Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior Office Action. Thus, the teachings of Vaidyanathan and Campbell when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious the limitations that Appellant disputes.

In response to Appellant's impermissible hindsight analysis, the Examiner respectfully submitted, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,
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Patent Examiner
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September 27, 2005

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